

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Goeller et al.

Application No.: 09/810,945

Filed: March 15, 2001

Title: POINT OF SALE CHECK SERVICE

Attorney Docket No.:
VISAP062/P11400

Examiner: Unassigned

Group: Unassigned

RECEIVED
OCT 04 2001
Group 2100

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail to: Commissioner for Patents, Washington, DC 20231 on September 26, 2001.

Signed:

Lara M. Nelson

PETITION TO MAKE SPECIAL FOR NEW APPLICATION
UNDER MPEP §708.02(VIII)

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby petitions to make this new application, which has not received any examination by the Examiner, special.

- ☒ All the claims in this case are directed to a single invention.
- ☒ If the Office determines that all the claims presented are not obviously directed to a single invention, Applicant will make an election without traverse as a prerequisite to the grant of special status.
- ☐ If claims _____ are found not to be examinable in this case with claim(s) _____, Applicant hereby elects claim(s) _____ for the prosecution of this case.

A search has been made by:

- | | |
|---|--|
| <input type="checkbox"/> the inventor | <input type="checkbox"/> attorney |
| <input checked="" type="checkbox"/> professional searcher | <input type="checkbox"/> foreign patent office |

in the following:

- ☒ field of search: classes _____, subclasses _____
- ☐ publications
- ☐ chemical abstracts
- ☐ foreign patents
- ☐ search by corresponding foreign patent office or at the former International Patent Institute at The Hague, Netherlands.

10/03/2001 KBERHE 00000085 09810945

01 FC:122

130.00 OP

VISAP062/P11400

☒ There is submitted herewith a copy of the references deemed most closely related to the subject matter encompassed by the claims.

☒ Form PTO-1449 is attached.

☒ There is submitted herewith a detailed discussion of the references which discussion particularly points out how the claimed subject matter is distinguishable over the references

Enclosed is our Check No. 12494 in the amount of \$110.00 to cover the Petition to Make Special filing fee. If the required fees are not enclosed or additional fees are required to facilitate filing of this paper, please charge such fees or credit any overpayment to Deposit Account No. 500388 (Order No. VISAP062).

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP



Phillip P. Lee

Registration No. 46,866

RECEIVED
OCT 04 2001
Group 2100

P.O. Box 778
Berkeley, CA 94704-0778
(650) 961-8300

7

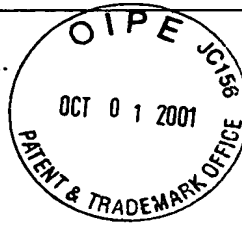
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Goeller et al.

Application No.: 09/810,945

Filed: March 15, 2001

Title: POINT OF SALE CHECK SERVICE



Attorney Docket No.: VISAP062/P11400

Examiner: Unassigned

Group: 2164

**DETAILED DISCUSSION OF THE REFERENCES
IN SUPPORT OF PETITION TO MAKE SPECIAL
UNDER MPEP §708.02 VIII**

Commissioner for Patents
Washington, DC 20231

RECEIVED
OCT 04 2001
Group 2100

Sir:

The following detailed discussion points out how the claimed subject matter is distinguishable over the references.

It is believed that claims 1-25 are directed to a single invention. However, should the examiner believe that claims 1-25 are not directed to a single invention, the examiner is invited to telephone the undersigned attorney in accordance with the established telephone restriction practice in order to allow the undersigned attorney to elect claims directed to a single invention.

The Present Invention

The present invention relates to point-of-sale check service system that converts any paper check transaction, at the point of sale, into an electronic funds transaction. The check service system operates in real time and while on-line such that electronic conversion and authorization processes are completed while a customer waits at the point of sale. This invention significantly reduces paper check processing costs for banks and merchants.

The check service system provides three authorization options, which include Conversion Only, Verification with Conversion, and Guarantee with Conversion. The Conversion Only option converts the paper check into an electronic transaction without any account verification processing. The Verification with Conversion option provides electronic conversion with verification from a drawee bank or a third-party authorizing agent that the check will be paid. The Guarantee with Conversion option provides electronic conversion with a guarantee from a check guarantor that the check will be paid.

Independent Claim 1

The following detailed discussion of the references particularly points out how the subject matter of claim 1 is distinguishable over the references. Therefore it appears that claim 1 is patentable over the results of the search.

U.S. Patent No. 6,006,208 issued to *Forst et al.*

Forst et al. relates to a system for making payments by which a payor can submit checking account information during a telephone conversation with a customer service representative.

First, *Forst et al.* does not teach or suggest a system for making payments that is implemented at the point of sale, as required by claim 1. Additionally, *Forst et al.* does not teach or suggest a drawee bank which receives transaction information or a drawee computer that is arranged to perform conversion, verification or guarantee based upon the transaction information, as specifically required by claim 1.

U.S. Patent No. 5,936,219 issued to *Yoshida et al.*

Yoshida et al. relates to an electronic payment system that records information that identifies checks issued during a specific time period so to prevent the receipt and acceptance of a previously issued check. In other words, this electronic payment system prevents a "double issue" or "double charge." The checks of the *Yoshida et al.* system are electronic checks issued by a payer's check issuing computer.

Yoshida et al. does not teach or suggest a device for receiving checking account information from a paper check, or a drawee computer that is arranged to perform conversion, verification or guarantee based upon transaction information, as specifically required by claim 1.

U.S. Patent No. 5,832,463 issued to *Funk*.

Funk, issued to EDS Corp., relates to a system for real-time conversion of paper checks issued by a participating bank or through an Automated Clearing House (ACH) transfer only. Therefore, this system is inapplicable for participating drawee banks. For non-participating banks, a paper check must be processed. The system is closed and only handles checks from institutions that are part of the EDS system.

Funk does not teach or suggest a drawee computer that is arranged to perform verification or guarantee based upon transaction information, as specifically required by claim 1.

U.S. Patent No. 5,053,607 issued to *Carlson et al.*

Carlson et al. relates to a check processing device used at a point-of-sale to process business transactions such as retail sale transactions. Generally, the check-processing device includes a MICR read head means, a printer means, a keypad means, and a CPU. *Carlson et al.* does not describe details as to a payment infrastructure.

Carlson et al. does not teach or suggest a drawee computer that is arranged to perform conversion, verification or guarantee based upon transaction information, as specifically required by claim 1.

U.S. Patent No. 5,175,682 issued to *Higashiyama et al.*

Higashiyama et al. relates to a system of processing checks by converting them into electronic form and transmitting the electronic information in batch mode, or in real-time if certain predefined circumstances are present.

However, *Higashiyama et al.* does not teach or suggest a drawee computer that is arranged to perform guarantee of checks based upon transaction information, as specifically required by claim 1.

U.S. Patent No. 5,532,464 issued to *Josephson et al.*

Josephson et al. relates to the traditional routing of paper checks between a presenting bank and a payor bank with the improvement of transmitting a cash letter in electronic form. A traditional paper cash letter is a list of check identification information corresponding to a particular batch of paper checks sent to a payor bank. The electronic cash letter speeds the check settlement procedures because it can be transmitted between the banks more quickly. *Josephson et al.* also describes a return item notification system that provides presenting bank with notifications of items previously presented that have been identified as exceptions by the payor bank.

Josephson et al. fails to teach or suggest a system wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required in claim 1. It is not surprising that *Josephson et al.* also fails to teach or suggest a drawee computer that is arranged to perform the conversion of paper checks into electronic checks, as is required in claim 1. Finally, *Josephson et al.* also fails to teach or suggest a drawee computer that is arranged to perform verification and guarantee based on transaction information, as is required in claim 1.

U.S. Patent No. 5,679,938 issued to *Templeton et al.*

Templeton et al. relates to a check acceptance system that provides interactive and off-line approvals of check transactions. The determinations as to approve or decline transactions are performed either at a transaction terminal located at the merchant site or by a check acceptance service. A check acceptance service is an institution that provides authorization indicia in response to various data, which includes data provided by the merchant.

Templeton et al. does not teach or suggest a drawee bank that receives transaction information, or a drawee computer that is arranged to perform conversion, verification or guarantee based upon the transaction information, as specifically required by claim 1.

U.S. Patent No. 5,703,344 issued to *Bezy et al.*

Bezy et al. relates to a real-time point of sale check confirmation and guarantee system using Visa-net for check issued by member or non-member third party institutions.

Bezy et al. does not teach or suggest a system that performs check conversions or a drawee computer that is arranged to perform conversions, as is specifically required by claim 1.

U.S. Patent No. 5,484,988 issued to *Hills et al.*

Hills et al. discloses check clearing system in which an ACH transaction is batch driven, and not in real-time. A point of sale terminal reads the MICR number from a consumer's check in order to verify that a consumer has an appropriate balance to conduct the transaction. The transaction information is transmitted to a central computer system, which verifies the consumer's credit worthiness and stores the transaction information for subsequent bank reconciliation via the ACH network. Additionally, conversions of *Hills et al.*, are not performed online, in real-time or against any possible bank.

Hills et al. does not teach or suggest a drawee bank that performs verification. Specifically, *Hills et al.* does not teach or suggest a drawee bank which receives transaction information from a switch computer, nor does *Hills et al.* teach a drawee computer of said drawee bank that receives said transaction information and is arranged to perform conversion, verification or guarantee, as required by claim 1.

U.S. Patent No. 4,758,714 issued to *Carlson et al.*

Carlson et al. discloses a point-of-sale mechanism used to process a sales transaction capable of securely locking negotiable instruments within a compartment so to prevent any

attempts to interfere with the transaction. Some embodiments of the mechanism are disclosed to have capability of verifying personal checks.

However, *Carlson et al.* fails to teach or suggest a drawee computer of said drawee bank that receives said transaction information and is arranged to perform conversion, verification or guarantee, as specifically required by claim 1.

Authorization Service Speeds Ross Checkout, *Chain Store Age Executive*, February 1988.

The “Authorization Service Speeds Ross Checkout” article discloses a system for electronically authorizing checks at the point of sale. The disclosed system verifies checks against negative files maintained by a non-bank-competing third party.

Consequently, the “Authorization Service Speeds Ross Checkout” article does not teach or suggest a drawee bank that performs verification. Specifically, the article does not teach or suggest a drawee bank which receives transaction information from a switch computer, nor does the article teach a drawee computer of said drawee bank that receives said transaction information and is arranged to perform conversion, verification or guarantee, as required by claim 1.

MICR Technology Helps Eliminate POS Check Fraud, *Chain Store Age Executive*, September 1991.

The “MICR Technology Helps Eliminate POS Check Fraud” article discloses a system for electronically authorizing checks at the point of sale through the use of MICR readers. The article discloses processing the check through a verification or approval system or by the Automated Clearing House. The article also discloses the ability to verify and guarantee a check.

However, the “MICR Technology Helps Eliminate POS Check Fraud” article does not teach or suggest a drawee bank that performs the verification or guarantee service. Specifically, the article does not teach or suggest a drawee bank which receives transaction information from a switch computer, nor does the article teach a drawee computer of said drawee bank that receives said transaction information and is arranged to perform conversion, verification or guarantee, as required by claim 1.

Therefore, for at least the reasons above, it is respectfully submitted that claim 1 is novel, nonobvious and patentable over the recited references.

Independent Claim 9

Claim 9 includes at least the same elements as described in claim 1. Therefore, it appears that claim 9 is patentable over the references discussed with respect to claim 1 for at least the reasons presented with respect to claim 1.

Accordingly, it is respectfully submitted that claim 9 is novel, nonobvious and patentable over the above mentioned references.

Independent Claim 17

The following detailed discussion of the references particularly points out how the subject matter of claim 17 is distinguishable over the references. Therefore it appears that claim 17 is patentable over the results of the search.

U.S. Patent No. 6,006,208 issued to *Forst et al.*

First, *Forst et al.* does not teach or suggest a method of performing a transaction at a point of sale as required by claim 17. *Forst et al.* also does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Forst et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,936,219 issued to *Yoshida et al.*

Yoshida et al. does not teach or suggest a step for receiving checking account information from a paper check of a customer. *Yoshida et al.* also does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Yoshida et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,832,463 issued to *Funk.*

Funk does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion with verification or conversion with guarantee, as

specifically required by claim 17. Additionally, *Funk* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,053, 607 issued to *Carlson et al.*

Carlson et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion with guarantee, as specifically required by claim 17. Additionally, *Carlson et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,175,682 issued to *Higashiyama et al.*

Higashiyama et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Higashiyama et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,532,464 issued to *Josephson et al.*

Josephson et al. does not teach or suggest an operation wherein a paper check is returned to the customer at the point of sale, wherein the paper check is not being used as a negotiable instrument. Also, *Josephson et al.* does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Josephson et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,679,938 issued to *Templeton et al.*

Templeton et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Templeton et al.* does not teach or suggest an operation for receiving a response message indicating a response to

the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,703,344 issued to *Bezy et al.*

Bezy et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. *Bezy et al.* describes two types of confirmation queries (requests), verification and guarantee, however, it does not teach a conversion request. See col. 3, lines 55-65. Additionally, *Bezy et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 5,484,988 issued to *Hills et al.*

Hills et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Hills et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

U.S. Patent No. 4,758,714 issued to *Carlson et al.*

Carlson et al. does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, *Carlson et al.* does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

Authorization Service Speeds Ross Checkout, *Chain Store Age Executive*, February 1988.

The "Authorization Service Speeds Ross Checkout" article does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. Additionally, this article does not teach or suggest an operation for receiving a

response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17.

MICR Technology Helps Eliminate POS Check Fraud, *Chain Store Age Executive*, September 1991.

The “MICR Technology Helps Eliminate POS Check Fraud” article does not teach or suggest an operation for assembling a service request message that includes a request to perform conversion only, conversion with verification, or conversion with guarantee, as specifically required by claim 17. This article also does not teach or suggest an operation for receiving a response message indicating a response to the request to perform conversion only, conversion with verification or conversion with guarantee, as specifically required by claim 17. Additionally, this article does not teach or suggest an operation for returning a paper check to a customer wherein the paper check is not used as a negotiable instrument.

Therefore, for at least the reasons above, it is respectfully submitted that claim 17 is novel, nonobvious and patentable over the recited references.

Independent Claim 20

The following detailed discussion of the references particularly points out how the subject matter of claim 20 is distinguishable over the references. Therefore it appears that claim 20 is patentable over the results of the search.

U.S. Patent No. 6,006,208 issued to *Forst et al.*

Forst et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. Additionally, *Forst et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of a plurality of banks, as specifically required by claim 20.

U.S. Patent No. 5,936,219 issued to *Yoshida et al.*

Yoshida et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Yoshida et al.* also does not teach or suggest

an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20.

U.S. Patent No. 5,832,463 issued to *Funk*.

Funk does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Funk* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20.

U.S. Patent No. 5,053,607 issued to *Carlson et al.*

Carlson et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Carlson et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, *Carlson et al.* does not teach or suggest a method of processing a paper check transaction wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

U.S. Patent No. 5,175,682 issued to *Higashiyama et al.*

Higashiyama et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Higashiyama et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20.

U.S. Patent No. 5,532,464 issued to *Josephson et al.*

Josephson et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Josephson et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, *Josephson et al.* does not teach or suggest a method of processing a paper check transaction

wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

U.S. Patent No. 5,679,938 issued to *Templeton et al.*

Templeton et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Templeton et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, *Templeton et al.* does not teach or suggest a method of processing a paper check transaction wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

U.S. Patent No. 5,703,344 issued to *Bezy et al.*

Bezy et al. also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, *Bezy et al.* does not teach or suggest a method of processing a paper check transaction wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

U.S. Patent No. 5,484,988 issued to *Hills et al.*

Hills et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Hills et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20.

U.S. Patent No. 4,758,714 issued to *Carlson et al.*

Carlson et al. does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. *Carlson et al.* also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, *Carlson et al.* does not teach or suggest a method of processing a paper check transaction wherein a

paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

Authorization Service Speeds Ross Checkout, *Chain Store Age Executive*, February 1988.

The "Authorization Service Speeds Ross Checkout" article does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. This article also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, this article does not teach or suggest a method of processing a paper check transaction wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

MICR Technology Helps Eliminate POS Check Fraud, *Chain Store Age Executive*, September 1991.

The "MICR Technology Helps Eliminate POS Check Fraud" article does not teach or suggest an operation for receiving a service request message from a point of sale wherein the service request message includes a request for a type of check service, as specifically required by claim 20. This article also does not teach or suggest an operation for determining whether the request for a type of check service matches with a service provided by one of the banks, as specifically required by claim 20. Additionally, this article does not teach or suggest a method of processing a paper check transaction wherein a paper check is not used as a negotiable instrument and is returned to a customer, as specifically required by claim 20.

Therefore, for at least the reasons above, it is respectfully submitted that claim 20 is novel, nonobvious and patentable over the recited references.

Dependent Claims

Claims 2-8, 10-16, 18-19, 21-25 each depend either directly or indirectly from claims 1, 9, 17 and 20 and are therefore submitted as novel, nonobvious, and patentable over the recited references for at least the reasons stated above with respect to the independent claims.

Specifically, dependent claims 2, 11, 19 and 21 are patentable for the reasons stated above with respect to their independent claims and for the additional reason that these claims pertain to communications that are online and in real-time.

Conclusion

The applicant respectfully submits that the above statement meets the requirements of MPEP §708.02(VIII) and respectfully requests the granting of the associated petition to make special. If the Examiner has any questions he or she is respectfully invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'Phillip P. Lee', written over a horizontal line.

Phillip P. Lee

Registration No. 46,866

P.O. Box 778
Berkeley, CA 94704-0778